

BEST AVAILABLE COPY

REMARKS

Upon entry of this amendment, claims 48-79 will be pending. Claims 1-34 and 43-47 have been canceled and claims 35-42 withdrawn without prejudice or disclaimer. The new claims introduce no new matter. Support may be found in the specification at, for example, page 2, lines 16-19 and 22-26; page 3, lines 7-9, 12-14, and 24-29; page 4, lines 4-7; page 9, line 15 to page 10, line 4; and Fig. 7

This invention discloses "smart books", that is books which can authorize their own copies, and the claims have been amended to more clearly recite smart books and methods and systems for their use. As recited in all independent claims, a smart book comprises a tangible and specific copy of a book with a physically-affixed tangible record of rights to make a certain number of future copies of that particular and specific copy. These specific and limited rights, referred to herein for brevity as "copyrights", are limited to the particular and specific book copy to which they are affixed, and are preferably not transferable to other tangible copies of the book. They are one of the bundle of rights granted if the work of which the smart book is a copy is also "copyrighted". The tangible "copy right" record must accommodate updating, so that as current copies are authorized correspondingly fewer copies can be authorized in the future.

In the preferred embodiments recited, the "copyrights" pertaining to a particular and specific copy of a book are stored in a semiconductor device physically affixed to that particular and specific copy of the book. When a copy is requested, the stored copyrights are retrieved to determine if the requested copy can be authorized; if so, it is authorized; and finally the stored "copyrights" are updated to reflect that fewer copies can be made in the future. "Copy right" retrieval, copy authorization (or not), and "copy right" updating may be done either by the semiconductor device itself under the control of resident software, or alternately, by the semiconductor device in cooperation with external systems. In order to provide for the external (preferably wireless) communication needed in order to authorize copies or to cooperate with external systems, and optionally, also to provide for executing resident software, the semiconductor device preferably includes controller functions.

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The Office Action rejected previously pending claims 1-17 and 43-46 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,742,039 to Sato et al. ("Sato") in view of U.S. Patent No. 5,991,876 to Johnson et al. ("Johnson") and further in view of U.S. Patent No. 6,486,780 to Garber et al. ("Garber").

The Applicants respectfully traverse this rejection. The combination of Sato, Johnson, and Garber cannot establish a proper *prima facie* case of obviousness of the pending claims because this prior art does not teach all elements present in the recited smart books, nor suggest their combination into a smart book with a likelihood of useful success. See the M.P.E.P. at, for example, § 2142 (required elements of a *prima facie* case of obviousness). In particular, this prior art does not teach a combination where a semiconductor device is affixed to a particular and specific copy of a book and stores copyrights for authorizing a limited number of further copies of that particular and specific copy to which the device is affixed, and where the stored copyrights can be updated as current copies are authorized so that fewer copies can be made in the future.

The principal reference, Sato, clearly does not teach smart books, either their recited elements or their recited combination. According to Sato's commodity management system, manufacturers attached labels with bar coded commodity management information to their products. See Sato at, for example, the Abstract, col. 1, lines 8-11; col. 4, lines 17-18; and col. 4, line 66 to col. 5, line 4. Commodity management information for books includes only titles, authors, publishers, dates, prices, ISBN codes, and the like. See Sato at, for example, col. 7, lines 32-36. Nowhere does Sato disclose or suggest that book commodity information can be used to authorize copies, like the recited copy right information. Further, this bar coded information can not be updated and is not stored in semiconductor devices.

The Johnson reference similarly does not teach smart books. Johnson discloses and teaches only data structures for central systems performing copyright clearinghouse functions. See Johnson at, for example, the Abstract; col. 2, lines 58-61; and col. 2, line 57 to col. 3, lines 6. The disclosed data structures are maintained and processed exclusively in central computer systems and track rights available for "works". See Johnson at, for example, col. 3, lines 48-58; and col. 4, lines 58-67. However, Johnson tracks rights for "works" considered generically (not

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for particular and specific copies of works); tracking copyrights for a specific, particular, and individual copy of a book is never disclosed or suggested. It follows, therefore, that Johnson cannot, and indeed does not, suggest affixing to a specific, particular, and individual copy of a book a tangible and updateable record tracking the number of copies that can be authorized.

Finally, Garber also does not disclose or suggest smart books. Although, this reference discloses that radio-frequency identification (RFID) tags affixed to books are useful in library management systems, nowhere is it suggested that these tags may also be useful for authorizing further copies of the specific, particular, and individual copy of a book to which they are affixed. A detailed reading reveals that Garber teaches that the disclosed RFID tags store only such library management information as a "library identification number", a "code designating whether the item was a book, a video tape, an audio tape, a CD, or some other item", an "identification of the article with which the tag is associated", an indication of "whether the article had been properly processed, a "circulation count", a "check-in status", and an "owning library". See Garber at col. 7, lines 54, 59-60; col. 8, lines 34-36; col. 12, line 53; and col. 17, lines 2-3, 16, and 21-22 (respectively). Nowhere does Garber disclose, or even bother to teach or suggest, that RFID tags might usefully store copyright information of any sort whatsoever.

Thus, the combination of Sato, Johnson, and Garber cannot establish a proper *prima facie* case of obviousness of the pending claims, because it does not teach, *inter alia*, a semiconductor device affixed to a book and storing updateable copyright information for authorizing a limited number of further copies of the particular and specific book copy to which the device is affixed. Nowhere in the prior art can be found a teaching of copy right information pertaining to a specific, particular, and individual copy of a book, and therefore, nowhere can be found a teaching of attaching a tangible and updateable record of such copyrights to the particular and specific book copy to which they pertain.

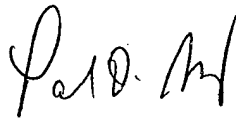
In the objective record of this application, these teachings can be found only in the Applicants' own disclosure. They are simply not present in the cited prior art. To nevertheless contend that the Sato-Johnson-Garber combination makes the pending claim obvious is certainly an example of impermissible hindsight. See the M.P.E.P. at, for example, § 2141.01(III).

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Accordingly, the independent claims and their dependent claims, which inherit and include the subject matter of their parents, are patentable over the prior art of record, the Sato, Johnson, and Garber references.

In view of the foregoing, Applicants respectfully submit that all the Examiner's objections and rejections have been addressed and that all of the claims in the present application are allowable. Accordingly, Applicants respectfully request that the claims be reconsidered and passed to allowance.

Respectfully submitted,



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